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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/518,060 | 03/02/2000 | Andrew Scott Field | KDO.188020-1 | 5292 |
| 25763 | 7590 | 01/08/2004 | EXAMINER | |
| DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498 | | | POND, ROBERT M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Response filed on 1st Jan

Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant filed a Request for Continued Examination under 37 CFR 1.114 requesting consideration of proposed amendment filed 06 October 2003 under 37 CFR 1.116. The Applicant canceled Claims 1, 4, and 12-16, and amended Claims 2-3, 5-7, and 9-11. All pending claims, 2-3 and 5-11, were examined in this non-final Office Action.

Response to Arguments

Applicant's arguments 06 October 2003 have been fully considered but they are not persuasive.

This examiner maintains the position on Freedman in view of Seybold Reports. Freedman discloses customers using an electronic network to conduct online business with a commercial printing services company. Seybold Report discloses use of the Internet as state of the art in the commercial printing industry. Since the Internet is a global communication network, one of ordinary skill in the art of managing a print service using a network as disclosed in Freedman would view the Internet as a technological uplift to the system and method of Freedman, and therefore would be motivated to investigate business impact resulting from a technological migration from a limited network to the global Internet.

This examiner maintains the position that the collection of articles designated as "Online Interactive Calculators" (OIC) offers a preponderance of evidence that would motivate one of ordinary skill to improve existing online print shop services by providing faster quoting services in order to be or remain competitive.

Freedman and Seybold Report state a goal of expediting print job estimating for an online customer and given the technological uplifts taught by Freedman and Seybold Report, it would be prudent business practice for one of ordinary skill in the art of managing an online print services business to assess the value to online customers by providing better and faster cost estimating tools (e.g. instant price estimating vs. hours, day, or days), and given the competitive frenzy catalyzed by the potential of Internet commerce, it would be prudent to implement interactive pricing calculators to neutralize the customer's perceived value of similar pricing tools offered by a competitor.

OIC teaches UPS' Quick Cost Calculator. New art was cited that discloses UPS' Quick Cost Calculator as being offered via a web browser (persistent connection to web server) or via a software download or diskette (for off-line use).

The taking of Official Notice (Claims 7 and 8) was not challenged by the Applicant and is therefore maintained.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

1. **Claims 2-3 and 5-11 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2-3, 5-6, and 9-11 are rejected under 35 USC 103(a) as being unpatentable over Freedman (Paper #6, patent number 4,839,829), in view of Seybold Report (a collection of articles cited in Paper #6, PTO-892 Items: U and V), further in view of Online Interactive Calculators (a collection of articles cited in Paper #8, PTO-892 Items: U-X, hereinafter referred to as "OIC"), further in view of UPS (a collection of articles cited in PTO-892, Items: U-V).**

Freedman teaches an automated control system and method for the printing of a work using a variety of conventional and emerging graphic arts processes and techniques. The system interacts with a user or customer, hereinafter referred to as a requester, over a computer network for collecting and storing information or parameters regarding the requester's needs (e.g. cost requirements, photos, pictures, graphics, colors used). The information gathered from the requester is correlated with a database of stored information from specific or various printing facilities, and the requester is instantaneously provided with accurate information regarding costs, print facility capacity,

Art Unit: 3625

scheduling, and with information relating to relevant alternatives which can expedite the ordering process (please see at least abstract; Fig. 1a (12, 20, 24, 36, 44); Fig. 2a; col. 1, line 10 through col. 4, line 2). Freedman teaches the network incorporating expert systems software that reviews the inputs from the requester. Once the central computer is provided with all the previously described information for the printing job, the computer automatically returns cost information, timing, and other pertinent information to the requester's computer. Freedman teaches requester batch loading and entire work and transmitting a work comprising: newsletters, magazines, books, pamphlets, poster, reports, flyers, direct mail items, directories, business cards and "virtually all types of printed matter," and delivering printed material to the requester (see at least col. 8, line 14). Freedman further teaches the requester connecting to the printing service remotely from home, office, or from an "in-house" computer located in the same building or building complex, and the online service collecting requester billing data (see at least col. 8, lines 1-5). Freedman further teaches supplying the service with printing parameter information specifying color printing requirements, and print process that support color printing (see at least col. 2, lines 32-33).

Freedman teaches all the above as noted under the 103(a) rejection and further teaches supplying to the requester a configurator, and returning an automated cost calculation back to the requester, but does not disclose supplying the cost calculator to the requestor. Seybold Report teaches the current state of

the printing industry regarding use of the Internet and further teaches A&a Printers establishing an Internet web site using HTML that allows requesters to submit print jobs online and to estimate job costs before committing to the printing service using online estimating tools to calculate shipping-weight and spine-thickness (see at least Item U, pages 2 and 7; Item V, pages 1-5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to supply cost calculators as taught by Seybold Report, in order to help requesters conveniently estimate printing costs prior to committing with a printing service provider.

Freedman teaches all the above as noted under the 103(a) rejection and further teaches use of computer networks and telephone lines as a communication medium, but do not specifically disclose a global communication network. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches use of the Internet to connect requesters with printing services. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to include the Internet as a global communications network as taught by Seybold Report, in order to market services on a global basis, and thereby increase revenue opportunities for the services site.

Freedman teaches all the above as noted under the 103(a) rejection and further teach printing to encompass any and all processes comprising letter press, intaglio, gravure, lithographic, electrophotographic, flexographic, ink jet,

thermographic, and offset lithographic (see col. 4, lines 33-35), but does not disclose a digital press. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches a company offering prepress operations and a graphic design agency that uses a variety of modern printing technologies including an Indigo E-Print digital press (see at least Item: U, pages 5 and 6). Therefore it would have been obvious to one of ordinary skill in the art a time of the invention to modify the system and method of Freedman to include a digital press as taught by Seybold Report, in order to sell services offering the advantages of newer printing technologies, and thereby attract more customers to the service.

Freedman and Seybold Report teach all the above as noted under the 103(a) rejection and teach cost estimating and use of a cost calculator but do not disclose online interactive calculators used for iteratively determining cost based on requester-supplied criteria. OIC teaches:

- Interactive web sites that help the requester, through interactive calculators, calculate required retirement savings using criteria comprising amount to be saved, interest rate, and time; a home-price calculator using salary, down payment, interest rate and other criteria to determine the type of house the user can afford; a car-buying cost calculator; a cost calculator for figuring student loan costs; and a salary relocation cost calculator (see at least Item: U, pages 1-2),

- Interactive cost calculator that advises on the cost of borrowing money and allows comparisons between each type of mortgage and their charges within a matter of seconds (see at least Item: V, pages 1-2),
- UPS' home page providing a Quick Cost Calculator to determine expenses (see at least Item: W, page 3), and
- Merrill Lynch's Personal Finance Center that provides clients with an interactive calculator to illustrate the cost of letting credit-charges pile up (see at least Item: X, page 3).

Therefore it would have been obvious to one of ordinary skill in the art to modify the system and method of Freedman and Seybold Report to provide faster cost calculation tools to requesters as taught by OIC, in order to provide competitive online print job estimating turn-around time, and thereby attract requesters to the online service site.

Freedman, Seybold Report, and OIC teach all the above as noted under the 103(a) rejection and teach interactive cost calculators used in Internet browsers to determine price quotes and further teach UPS' Quick Cost Calculator, but do not disclose calculating and displaying the price quote without querying a service provider's server. UPS teaches UPS' Quick Cost Calculator being available in an online Web version (please note the Web version requires a persistent connection to the web server via the Internet), or being available in a stand-alone version (diskette or through software download from the UPS web site) to be

executed on the client computer (Item: U, see at least page 2; Item: V, see at least pages 2, and 4-8). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman, Seybold Report, and OIC to include a client version of the online interactive cost calculator as taught by UPS, in order to permit off-line use of the cost calculator on a client machine.

- 3. Claims 7 and 8 are rejected under 35 USC 103(a) as being unpatentable over Freedman (Paper #6, patent number 4,839,829), Seybold Report (a collection of articles cited in Paper #6, PTO-892 Items: U-V), OIC (a collection of articles cited in Paper #8, PTO-892 Items: U-X), and UPS (a collection of articles cited in PTO-892, Items: U-V), as applied to Claim 2, in further view of Official Notice (regarding approval for proofs).**

Freedman, Seybold Report, OIC, and UPS teach all the above as noted under the 103(a) rejection and further teach electronic job submission comprising copy and proofs and accessing proofs electronically via URLs (see at least Item U, page 2), but does not disclose obtaining approval from requesters of said proofs. This examiner takes the position that the primary purpose of using proofs is to gain approval from the requester prior to purchasing the finished product. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freedman, Seybold Report, OIC, and UPS to obtain requester's approval of the electronically accessible proofs as taught by

Art Unit: 3625

Official Notice, in order to ascertain the requester's agreement with the proposed finished product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

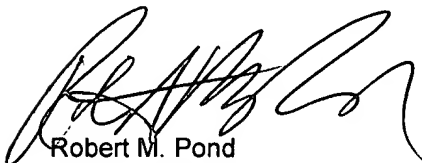
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
December 23, 2003